

REMARKS

Claims 1-32 are pending in the present application. Claims 1-23 are amended by this response, and claims 24-32 are added. Claims 1 and 19 are independent claims.

Restriction Requirement

Claims 1-23 are subject to a restriction requirement for alleged lack of unity of invention. The claims are divided into Group I, comprising claims 19-23, which are drawn to an electronic module, and Group II, comprising claims 1-18, which are drawn to a method for manufacturing an electronic module. Insofar as it pertains to the presently pending claims this restriction requirement is respectfully traversed.

According to the M.P.E.P., the claims in an Application “may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent or distinct (M.P.E.P. §803).

The Office Action alleges that “the inventions listed as Groups II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2 they lack the same or corresponding special technical features.”

No Prior Art Applied

Rule 13.2 states that “Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression ‘special technical

features' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art."

The Examiner's rationale for applying PCT Rule 13.2 is that "Instead of a support layer is attached to the conductive layer and is removed after the manufacture of the insulating material layer, but before the manufacture of the conductive patterns, the support layer can be formed only in the portions that remain attached to the conductor layer forming the conductive patterns." (Page 2 of Office Action).

Applicants respectfully submit that since the claims have not yet been substantively examined, and no prior art references have been applied, the Examiner has no basis for concluding whether the support layer, as recited in dependent claim 10, is a "special technical feature" as required by PCT Rule 13.2.

Dependent Claim

Applicants further submit that this rationale is only applicable to dependent claim 10 of Group I as no other claims in Group I recite a support layer. Dependent claims are acknowledged as having a greater degree of flexibility in their claim scope than independent claims under the PCT Rules. Specifically, PCT Rule 13.4 states that "subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention." Rule 13.4 clearly states, therefore, that the invention is defined by the independent claim for unity of invention purposes and that specific forms of that invention are

permitted in dependent claims “even where the features of any dependent claim could be considered as constituting in themselves an invention.” Applicants respectfully submit that dependent claim 10 is therefore not properly restrictable by itself, nor does it in any way affect a unity of invention analysis on independent claim 1.

Corresponding Technical Features

Applicants further submit that Rule 13.2 pertains to the same *or corresponding* technical features. The Examiner’s rationale supporting restriction is that there are two different, but related, approaches for forming a structure named in dependent claim 10. Applicants respectfully submit that two different, but related, approaches are the same as *corresponding technical features*.

Conclusion

The Examiner has made no showing that any of the independent claims of the present invention are independent or distinct from any other independent claims of the present invention. The Examiner has further made no showing under the PCT rules that there is a lack of unity of invention as required by PCT Rule 13.2.

Even assuming, *in arguendo*, that dependent claim 10 does recite a substantially different invention than independent claim 1, lacking a showing of distinction or independence among the independent claims, the Examiner may not restrict an entire group of claims solely on the basis of one independent claim within that group.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this restriction requirement.

Because election is required regardless of traversal, Applicants elect Group II.

In view of the above amendment and remarks, Applicants believe the pending application is in condition for allowance on all pending claims. Thus, the Examiner is respectfully requested to reconsider the outstanding restriction requirement and issue a Notice of Allowance in the present application.

However, should the Examiner believe that any outstanding matters remain in the present application, the Examiner is requested to contact Applicants' representative, Naphtali Matlis (Reg. No. 61,592) at the telephone number of the undersigned in order to discuss the application and expedite prosecution.

Dated: April 11, 2008

Respectfully submitted,

By 

Michael K. Mutter

Registration No.: 29,680

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Rd

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicants